

Remarks

Applicants submit the following amendments and remarks in response to the office action and restriction requirement mailed on November 23, 2005, setting a period for response expiring December 23, 2005. A petition for one month extension with the appropriate fee has been filed herein to extend the response period to January 23, 2006. Accordingly, this response is timely filed. If there is any other fee due, the Office is authorized to charge Deposit Account No. 500239.

Claims 20-24 are pending in this application. Claim 20 has been amended to better clarify the scope of the claim, i.e., a stable disodium salt of fosfluconazole in the form of its trihydrate, its hexahydrate, or as a mixture of tri- and hexahydrates. Support for the amendment regarding the stability of the disodium salt of fosfluconazole hydrate forms of the invention can be found throughout the specification as filed. Further, the term "The" in the beginning of the claim has been amended to read "A" to facilitate proper claim language, and set a clear antecedent basis for claims 21-24. Claims 21-24 are hereby amended so that now they are dependent from claim 20. The amendments are of the formal nature and do not add new matter. Upon entry of this amendment, claims 20-24 are pending in the application.

Election/Restrictions

The Examiner has imposed a three-way restriction in the present application (Groups I-III) as follows:

Group I: Claim 20 drawn to the disodium salt of fosfluconazole in the form of its trihydrate, its hexahydrate, or as a mixture of tri- and hexahydrates, wherein the trihydrate has a water content about 11% w/w and the hexahydrate has a water content of about 20% w/w.

Group II: Claims 21-23 drawn to a hydrate mix of trihydrate and hexahydrate of fosfluconazole disodium salt, where in the water content of said mix is from about 11% w/w to about 20% w/w.

Group III: Claim 24 drawn to a stable mix of trihydrate and hexahydrate of disodium salt of fosfluconazole wherein the trihydrate has a water content of about 11% w/w and the hexahydrate has a water content of about 20% w/w, made by a process described therein.

Applicants hereby elect group I for initial examination, with traverse, on the grounds that the restriction requirement is improper. Applicants request that the restriction be withdrawn. If the restriction requirement is not withdrawn, applicants reserve the right to retain the right to rejoinder and/or to pursue the non-elected subject matter in a later filed divisional application.

According to M.P.E.P. § 803 the Examiner can only restrict patentably distinct inventions when (1) the inventions are independent or distinct as claimed and (2) where there would be a serious burden on the Examiner if restriction is not required.

Burdensome Search and Examination

Applicants respectfully submit that the Examiner has made no showing that prosecuting all present claims in one application would be seriously burdensome. Applicants submit that searches for any of the Examiner's Groups I-III cannot be seriously burdensome. In discharging

her obligation to conduct a diligent search, the Examiner must search all classes and subclasses that may have material pertinent to the subject matter as claimed. M.P.E.P. § 904.02(a) states that:

"In outlining a field of search, the Examiner should note every class and subclass under the U.S. Patent Classification System and other organized systems of literature that may have material pertinent to the subject matter as claimed. Every subclass, digest, and cross reference art collection pertinent to each type of invention claimed should be included, from the largest combination through the various sub-combinations to the most elementary part. The fields of search should extend to all probable areas relevant to the claimed subject matter and should cover the disclosed features which might reasonably be expected to be claimed..." (emphasis added)

Clearly, the cited M.P.E.P. above suggests that the Examiner's field of search is not necessarily limited to one class and subclass. In the present case, Applicants submit that claims 20-24 are pending and that it is reasonable to expect that each of the classes and subclasses identified in each group I-III extend to areas relevant to the claimed subject matter of any other groups.

Further, it is noted that the previous Examiner in the pre-RCE prosecution period had imposed a two-way restriction requirement in an office action mailed January 17, 2005, in the present application (Groups I-II) as follows:

Group I: Claims 1-19 drawn to a process for preparing a stable hydrate (class 252, subclass 70);

Group II: Claim 20 drawn to a disodium salt of fosfluconazole (class 424, subclass 401).

In response to the restriction requirement mailed on March 11, 2005, Applicants had elected the original claim 20, which is Group II. It is noted that the subject matter of the presently pending claims 20-24 as amended are within this previously elected group II.

Request for Withdrawal of Restriction Requirement or Rejoinder

Applicants note that claims 21-24 as amended depend from claim 20, and therefore incorporate all the elected claim limitations recited therein. Applicants respectfully request withdrawal of the present restriction requirement of Groups I-III and allow the non-elected claims 21-24 to be examined together in the same patent application.

Alternatively, applicants request withdrawal of the present restriction requirement of Groups I-II and allow the non-elected product claims 21-23 to be examined together in the current application and, upon allowance of the elected product claim 20, applicants request rejoinder of the non-elected product by process claim 24, in accordance with M.P.E.P. §821.04:

"In order to be eligible for rejoinder, a claim to a nonelected invention must depend from or otherwise require all the limitations of an allowable claim. A withdrawn claim that does not require all the limitations of an allowable claim will not be rejoined. Furthermore, where restriction was required between a product and a process of making and/or using the product, and the product invention was elected and subsequently found allowable, all claims to a nonelected process invention must depend from or otherwise require all the limitations of an allowable claim for the claims directed to that process invention to be eligible for rejoinder... In order to retain the right to rejoinder, applicant is advised that

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the claims to the nonelected invention(s) should be amended during prosecution to require the limitations of the elected invention."

Independent product claims 21 and 24, and therefore the dependent claims 22-23, have been amended to incorporate all the limitations of the stable disodium salt of fosfluconazole in the form of its trihydrate, its hexahydrate, or as a mixture of tri- and hexahydrates of claim 20. Therefore, the claims are qualify for rejoinder.

In view of the above claim amendments, Applicants respectfully requests that the Examiner withdraw the restriction requirement and rejoin the claims.

Respectfully submitted,

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Elsa Djuardi, Ph.D.
Attorney for Applicants
Reg. No. 45,963

Pfizer Inc.
Patent Dept.
10777 Science Center Drive
San Diego, CA 92121
Tel: (858) 638-6117
Fax: (858) 678-8233